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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,517	08/17/2000	Mitsuru Tanabe	KOIK-Q9495	8570

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER

BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/622,517

Applicant(s)

TANABE ET AL.

Examiner

Bradley Bayat

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/17/00.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☒ Claim(s) 4-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Japanese Application No. P10-369414, filed on 12/25/98.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

Claims 4-14 are objected to because of the following informalities: The claims are preceded by the term "(added)," however; all claims were filed with the original application. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it is indefinite whether "the time information" refers to the actual time of duplication or the number of times data has been duplicated.

Claims 1-3 recite the limitation "the information" in lines 2, 10 and 19. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 9-12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaniwa et al., U.S. Patent No. 5,699,370.

As per claim 1, Kaniwa et al. discloses an information processing apparatus comprising: storage means for storing the information for discriminating contents and the time information for the time the contents have been duplicated (see column 4, lines 24-33); acquisition means for acquiring the information for discriminating contents to be duplicated (see column 4, lines 1-14); and duplication means for duplicating the contents in association with the discrimination information acquired by said acquisition means and the time information held in said storage means (see column 4, lines 15-24).

As per claims 2 and 3, Kaniwa et al. discloses an information processing method and a program storage medium having stored therein a computer-readable program, comprising: a storage step for storing the information for discriminating contents and the time information for the time the contents have been duplicated (see column 7, lines 27-33); an acquisition step for acquiring the information for discriminating contents to be duplicated (see column 7, lines 40-62); and a duplication step for duplicating the contents in association with the discrimination information acquired by said acquisition step and the time information held in said storage step (see column 5, lines 34-36).

As per claim 4, Kaniwa et al. discloses an information processing method according wherein said contents are reproduced from an information storage medium (see column 4, lines 42-45).

As per claim 5, Kaniwa et al. discloses an information processing method wherein said information recording medium is a compact disc memorizing the music information (see figure 2, element 40).

As per claim 9, Kaniwa et al. discloses an information processing method wherein the discriminating information and temporal information are memorized in association with each other in a terminal database at the storage step (see figure 13).

As per claim 10, Kaniwa et al. discloses an information processing method further comprising a step of checking data in said terminal database; said checking step detecting possible modification using a hash function (see column 28, lines 36-52).

As per claims 11 and 12, Kaniwa et al. discloses an information processing method wherein said duplicating step further includes a decision step of comparing the current temporal information to the temporal information of the memorized contents when the discriminating information of said contents acquired at said acquisition step is detected to have been memorized in the past in said storage step to verify whether or not a time period not less than a pre-set time has elapsed; and as a result of decision at said decision step, said pre-set time has not elapsed, duplication is prohibited (see column 5, lines 59-67; column 6, lines 1-12).

As per claim 14, Kaniwa et al. discloses an information processing method used in an information processing apparatus having a database in which a discriminating code for discriminating contents duplicated in the past and the temporal data as to the time of duplication of said contents are stored in association with each, said method comprising: an acquisition step of acquiring a discriminating code of contents about to be duplicated other (see column 4); a decision step of determining whether or not said discriminating code acquired at said acquisition step has already been stored in said database (see column 4); a comparison step of comparing the current temporal information with the temporal data stored in said database in association with said current temporal information when said discriminating code is determined by said decision step to be already stored in said database (see column 4); and a decision step of verifying whether or not a time period not shorter than a pre-set time has elapsed since the temporal data stored in said comparison step until the current time; wherein if, as a result of said decision step, the time period not shorter than a pre-set time has not elapsed, the duplication of said contents is prohibited (see column 5; column 6, lines 1-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaniwa et al., U.S. Patent No. 5,699,370 in view of Endoh, U.S. Patent No. 4,965,680

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As per claims 6-8, Kaniwa et al. discloses an information recording and reproducing apparatus to be controlled by temporal information (see abstract). Kubota et al. does not teach the use of an International Standard Recording Code (ISRC), an identification tool used in electronic music distribution and rights administration. Endoh teaches the use of ISRC and other identifying information, i.e., table of contents for use in recording (see column 13-32). Endoh is evidence that one of ordinary skill in the art would recognize the benefit of utilizing the ISRC coding mechanism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention utilize the ISRC identification system made available primarily for such a purpose, as per teachings of Suzuki et al.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaniwa et al., U.S. Patent No. 5,699,370 in view of Suzuki et al., U.S. Patent No. 5,621,810.

As per claim 13, Kaniwa et al. discloses an information recording and reproducing apparatus to be controlled by temporal information (see abstract). Kubota et al. does not teach the use of a watermark detection mechanism. Suzuki et al. teaches a watermark detection mechanism in relation to an image reading or processing with the ability to prevent copying (see column 5, lines 55-56; figures 4 and 8). Suzuki et al. is evidence that one of ordinary skill in the art would recognize the benefit of a watermark detection mechanism. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention to initiate or prohibit duplication based on the watermark detection mechanism, as per teachings of Suzuki et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Edwards, Jr. discloses a system with software usage timer and counter for allowing limited use but preventing continued unauthorized use of protected software.

-Okamoto et al. discloses a recording apparatus and reproducing apparatus for video signals.

-Hirata discloses a recording and reproducing apparatus to selectively control the number of copies made.

-Sugiyama et al. discloses a recording and reproducing system for protecting copyrighted data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6128 for regular communications and 703-746-6128 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5484.

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November 1, 2002

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JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600